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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,495

03/18/2004

Donald R. Titterington

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WELLS ST. JOHN P.S.  
601 W. FIRST AVENUE, SUITE 1300  
SPOKANE, WA 99201

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/804,495	<b>Applicant(s)</b> TITTERINGTON ET AL.	
	<b>Examiner</b> Rabon Sergent	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-32, 46, 47 and 49-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-32, 46, 47 and 49-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10, 2008 has been entered.
2. The terminal disclaimer filed on March 10, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 7,311,767 has been reviewed and is accepted. The terminal disclaimer has been recorded.
3. The amendment filed March 10, 2008 is objected to as failing to comply with the provisions of 37 CFR 1.121. The claim listing fails to set forth claim 48.
4. Claims 30 and 31 are objected to as being duplicates.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Hays ('477).

Patentee discloses the production of oligomeric reaction products of isocyanates and rosin-based capping agents, such as hydroabietyl alcohol, suitable for use within ink compositions. See abstract; column 3, lines 21+; column 4, lines 7+; column 6, lines 26+; and column 7, lines 23-26. In view of the disclosed product and its use and further in view of the fact that the respective reactants are equivalent, the position is taken that specifying the ink as a phase change ink fails to distinguish the claims from the prior art, because one would reasonably expect the ink of Hays to inherently be a phase change ink.

7. Claims 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hays ('477).

As aforementioned, patentee discloses the production of oligomeric reaction products of isocyanates and rosin-based capping agents, such as hydroabietyl alcohol, suitable for use within ink compositions. See abstract; column 3, lines 21+; column 4, lines 7+; column 6, lines 26+; and column 7, lines 23-26. In view of the disclosed product and its use and further in view of the fact that the respective reaction products are equivalent, the position is taken that specifying the ink as a phase change ink fails to distinguish the claims from the prior art, because one would reasonably expect the ink of Hays to function as a phase change ink.

8. If it is determined that the sequence of reaction causes the reference to not be anticipatory, then the position is taken that it would have been obvious in view of the teachings of the reference to simply combine the disclosed diol, monomeric diisocyanate, and fused ring alcohol capping agent in essentially a one-shot process such that a monomeric diisocyanate would react with a mixture of alcohols including the fused ring alcohol. This position is bolstered by the fact that it has been held *prima facie* obvious to select any order of mixing ingredients or performing process steps in the absence of new or unexpected results. *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930). *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (MPEP 2144.04).

9. Applicants' response has been considered; however, applicants have failed to explain why Hays fails to disclose or suggest every limitation of the claims.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 21-32, 46, 47, and 49-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following claims of the following copending applications:

<u>Application</u>	<u>Claim</u>
10/902,602	96 and 97
11/291,057	57 and 58
11/496,231	27
11/496,612	21 and 22

Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of copending claims is drawn to phase change ink compositions or their use, wherein the compositions are derived from fused ring alcohols, such as hydroabietyl alcohol, and either cyclohexyl isocyanate or isophorone diisocyanate. The position is taken that

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one of ordinary skill in the art in possession of the phase change ink composition would have also been in possession of the method of making it. Furthermore, the phase change ink composition, by its very name and nature, renders the use of the composition, to the extent claimed, obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/  
Primary Examiner, Art Unit 1796

R. Sergent  
March 18, 2008